REMARKS

Claims 1 to 28 and 31 to 33 are pending, of which Claims 1, 11, 16 and 24 are independent. Claims 5 and 6 are being amended. Reconsideration and further examination are respectfully requested.

Claim 5 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly lacking sufficient antecedent basis. Without conceding the correctness of the rejection, Claims 5 and 6 are being amended. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1, 5 to 12, 15 to 21, 24, 25, 27 and 31 to 33 are rejected under 35 U.S.C. § 102(b) over an article entitled "The HotMedia Architecture: Progressive and Interactive Rich Media for the Internet", Kumar, et al., (referred to herein as Kumar), Claims 2 to 4, 13, 14, 22, 23, 26 and 28 are rejected under 35 U.S.C. § 103(a) over Kumar, with Claims 4 and 26 being rejected under over Kumar and the Official Notice taken by the Examiner. Reconsideration and withdrawal of the rejection are respectfully requested for at least the reasons set forth below.

Claim 1 recites a method for providing an ad via a computer network. According to the method, an ad input file is combined with a conduit file to create an integrated ad file containing computer code for providing the ad. The ad input file identifies the content of the ad and the conduit file identifies tracking data for the ad. The integrated ad file is served from a computer to provide the ad.

Kumar fails to teach, suggest or disclose multiples elements of Claim 1, including that of combining two files, an ad input file which identifies ad content and a conduit file which identifies tracking data for the ad to create an integrated ad file, and serving the integrated ad file from a computer to provide the ad.

Kumar describes a system by which a user referred to in Kumar as a content creator uses an authoring tool to specify multimedia content and actions that can be performed and tracked relative to the media content. The content creator defines the contents of the media file, which consists of frames of the type header, thumbnail, media, meta and endofstream. As is described in the section entitled "V. Creation" commencing at page 258 of Kumar, during a content creation phase the content creator uses the authoring tool to create the media file that is to be transmitted to a user's computer. Figures 8 and 9 (at pages 258 and 260 of Kumar) shows the

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user interface provided by the authoring tool. To generate a media file with media content using the authoring tool's user interface, the content creator selects a media type and then selects the content within the selected media type. Kumar describes a process whereby a user can specify a user action and can track such action using a token, which is added to the media file. Figure 16 at page 265 of Kumar shows the work flow whereby the content creator interacting with the authoring tool specifies an action, trigger and token. As shown in Figure 16 of Kumar, the content creator identifies a range in an image to be associated with a trigger and an action to be taken in response to the trigger. In a case that the content creator specifies tracking, the content creator also identifies a token/value pair, with the value being specified in the media file with the token or computed by the client after the media file is transmitted to the client. As is described at page 255 (in the section entitled "III. Architectural Overview") and shown in Figure 3 of Kumar, the media file created by the content creator using the authoring tool is stored and can be deployed to a client computer. Figure 15 and pages 264 and 265 of Kumar describe that the media specified in the media file is deployed with the tokens defined by the content creator using the authoring tool, which Kumar refers to as "rich-content with tracking information".

The Office Action cites Figures 3, 15 and 16, and pages 255, 256 and 264 to 266 of Kumar and states:

> [r]egarding claims 1 and 33, Kumar teaches an ad input file (media data) with a conduit file (tracking token) to create an integrated ad file (rich media content with tracking information); containing computer code for providing the ad (interactive rich media) and serving the integrated ad file from a computer (server) to provide the ad (dynamically generated page) suggests that the tracking token described in Kumar corresponds to the conduit file.

Kumar describes a single file, the media file, (that the Examiner equates with the claimed ad input file) which consists of types of data frames, one of which is a meta frame which can include tracking tokens, which are not files, and which are specified by the media content creator while interacting with an authoring tool. As is clear from the description provided by Kumar and the above discussion of Kumar, a token is simply a parameter, defined as a token value pair (a url or other alpha-numeric parameter) generated by the authoring tool based on input provided by the content creator using the authoring tool, and merely serves as one part of the created media file. Kumar's token, which is a part of the Kumar media file itself, cannot be said to correspond

to the claimed conduit file, which, as claimed, is a separate file from the ad input file until the integrated ad file is created. The Kumar media file is precisely what the claimed invention intends to overcome as a shortcoming, since modification of the Kumar media file token necessarily entails modification of the Kumar media file. Furthermore, nothing in Kumar teaches, suggests or describes combining an ad input file with a conduit file to create an integrated ad file. Nothing in Kumar, and in particular Kumar's token parameter, teaches, suggests or discloses the claimed conduit file, let alone combining an ad input file with a conduit file to create an integrated ad file.

For at least the foregoing reasons, Claim 1 is believed to be patentable over Kumar. In addition, Claims 2 to 10 and 33, which depend from Claim 1, are also believed to be patentable over Kumar for at least the same reasons.

Furthermore, and with respect to Claim 2, a modified integrated ad file is created by combining a received modified ad input file representing a change to the content of an ad with the conduit file. Claim 3 recites steps of receiving a modified conduit file representing a change to the tracking data, combining the modified conduit file with the ad input file to create a modified integrated ad file, and serving the modified integrated ad file, to provide an ad having the changed tracking data.

In view of the above discussion of Kumar and the description provided by Kumar, nothing in Kumar can be said to correspond to a conduit file, let alone combining the conduit file with a modified ad input file, which represents a change to the content of an ad, to create a modified integrated ad file, or combining a modified conduit file, which represents a change to the tracking data, with an ad input file to create a modified integrated ad file.

In rejecting Claims 2 and 3, the Office Action contends that Kumar provides the ability to customize tracking during content creation and choose the tracking information to be send to a tracking server. Even assuming, arguendo, that Kumar provides these features (an assumption that is in no way conceded), such features fail to teach, suggest or disclose a conduit file, let alone combining the conduit file with a modified ad input file, which represents a change to the content of an ad, to create a modified integrated ad file, or combining a modified conduit file, which represents a change to the tracking data, with an ad input file to create a modified integrated ad file.

As is discussed above, any customization at the content creation phase is limited to specification of a tracking token by a content creator using an authoring tool. A token parameter generated by the authoring tool based on input provided by the content creator using the authoring tool cannot be said to teach, suggest or disclose the claimed conduit file. In addition, reference is respectfully made to Figure 15 which shows a HotMedia Applet, and the discussion of the applet found at page 265 of Kumar. More particularly, Kumar describes an applet apart from the rich-media content and tracking information, the applet executes on the end user's computer and can be used to change the name of a token, or to send only a subset of the tracking information to the tracking server. As is clearly shown in Figure 15 and described at page 265 of Kumar, the applet is a discrete component, which executes on an end user's computer to send tracking information from the Kumar media file to a tracking server. Such a discrete component cannot be said to teach, suggest or disclose an integrated ad file created by combining an ad input file and a conduit file, let alone creating a modified integrated ad file by combining a modified ad input file and a conduit file or by combining a modified conduit file with an ad input file, and then serving the modified integrated ad file. For at least the foregoing reasons, Claims 2 and 3 are believed to be patentable over Kumar.

Referring to Claim 4, the Office Action admits that Kumar fails to disclose an ad which is a Flash ad. The Office Action, however, takes Official Notice and contends that use of a Flash ad is well known. In response, should the Examiner maintain the rejection, Applicants respectfully request that the Examiner provide evidence to support the Official Notice taken in the Office Action, and provide evidence to support the contention that use of a Flash ad in combination with the elements recited in Claim 1 would have been obvious. Applicants make a similar request with regard to Claim 26, which depends from Claim 24, and which was rejected under the same rationale as Claim 4.

Referring to Claim 5, the ad input file includes an empty movie clip object and the combining includes inserting the conduit file into the empty movie clip object. Claim 6 further recites that the empty movie clip object is given a predefined name and the combining the ad input and conduit file includes searching the ad input file for the predefined name. The Office Action generally refers to "media frames" and cites pages 256 and 257 of Kumar in rejecting Claims 5 and 6. However, from a review of Kumar, and in particular pages 256 and 257, the

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description is limited to a description of the format of a HotMedia file, and nothing can be found in the media file format description provided by Kumar that in any way teaches, suggests of discloses an empty movie object, let alone inserting a conduit file into the empty movie clip or searching an ad input file for a predefined name for the empty movie clip object. Should the Examiner maintain the grounds for rejection of Claims 5 and 6, Applicants respectfully request that the Examiner clarify her position as to what specifically the Examiner considers in Kumar to correspond to the claimed empty movie clip object, combining an ad input file and a conduit file including inserting the conduit file into the empty movie clip of the ad input file, and combining an ad input file and a conduit file including searching the ad input file for a predefined name of the empty movie clip of the ad input file.

For at least the foregoing reasons, Kumar is missing multiple elements of Claims 1 to 10 and 33. Kumar cannot therefore form the basis for a § 102 rejection, and reconsideration and withdrawal of the § 102(b) rejection of Claim 1 to and Claims 2 to 10 and 33 are respectfully requested. Furthermore, Kumar cannot form the basis of a §103(a) rejection, as the record is devoid of a teaching of the missing elements or a reason to provide same.

Turning to Claim 11, a method is recited of facilitating providing an ad. According to the method, first and second files are identified. A placeholder is identified in the first file, and the second file is electronically inserted into the placeholder to create the ad file. The ad file includes computer code for providing the ad.

With regard to Claims 11, 12, 15, 16, 24 and 25, the Office Action contends (at page 3) that:

> "Kumar teaches identifying a first file (media data); identifying a second file (tracking data)[;] identifying a placeholder in the first file (media frame) and electronically inserting the second file in the placeholder to create an ad file (a hotmedia file including the header, thumbnail, media, meta or endofstream); wherein the first file specifies ad content code and the second file contains ad-tracking code (see pp 256-257, 263-265)."

As is described at page 257 of Kumar, a media frame contains media bit-stream data, i.e., the media data, and configuration information for configuring a media player. A media frame that contains media data cannot be said to teach, suggest or disclose a first file containing a placeholder, let alone the step of identifying the placeholder in a first file. Furthermore, nothing in the cited portion of Kumar teaches, suggests or discloses electronically inserting a second file

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into the placeholder identified in a first file to create an ad file, and/or an ad file including computer code for providing an ad, which ad file is created by electronically inserting a second file into a placeholder identified in a first file.

For at least the foregoing reasons, Claim 11 and Claims 12 to 15, which depend from Claim 11, are believed to be patentable over Kumar. Furthermore and for at least the same reasons, Claim 24 and Claims 25 to 28, 31 and 32, which depend from Claim 24, are believed to be patentable over Kumar.

In addition, Claim 12, which depends from Claim 11, further recites that the first file specifies ad content code and the second file contains ad-tracking code. Claim 12 is believed to be patentable over Kumar for the reasons discussed with respect to Claim 11. In addition, it is respectfully submitted that Kumar fails to teach, suggest or disclose electronically inserting a second file containing ad-tracking code into the placeholder identified in a first file which specifies ad content code to create an ad file, and/or an ad file including computer code for providing an ad, which ad file is created by electronically inserting a second file containing ad-tracking code into a placeholder identified in a first file which specifies ad content code.

Claim 13 depends from Claim 12 and recites additional elements of receiving a modified first file which represents a change to the ad content and including the placeholder, and inserting the second file into the placeholder in the modified first file to create a modified ad file. Claim 14 depends from Claim 11 and indicates that the first file identifies ad tracking data and recites the additional elements of receiving a modified first file representing a change to the tracking data, and inserting the second file into the placeholder in the modified first file to create a modified ad file.

Based on the above discussion of Kumar, including the discussion of Kumar with respect to Claims 2, 3 and 11, nothing in Kumar can be said to teach suggest or disclose inserting a second file into a placeholder of a modified first file to create a modified ad file, let alone inserting a second file containing ad-tracking code into a placeholder of a modified first file, which modified first file represents a change to ad content, to create a modified ad file, or inserting a second file into a placeholder of a modified first file, which modified first file represents a change to tracking data, to create a modified ad file.

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Claim 15 recites the added feature that the first placeholder is an empty movie clip. Based on the discussion provided above with respect to Claims 5 and 6, it is clear that Kumar cannot be said teach, suggest or disclose an empty movie clip object as a placeholder in a file, let alone an empty movie clip into which a first file is electronically inserted into a third file.

Claim 31, depends from Claim 24, and further recites that the integrated ad file includes one or more exit codes referring to one or more URL variables. Claim 32, which depends from Claim 31, further recites that the integrated ad file is designed to be loaded by code, the code specifying one or more URLs corresponding to the one or more URL variables referred to by the one or more exit codes included in the integrated ad file, the code populating the one or more URL variables with the one or more URLs.

In rejecting Claims 31 and 32, the Office Action generally cites pages 257 to 262. Upon a review of the cited portion of Kumar, nothing was found that can be said to teach, suggest or disclose the elements recited in Claims 31 or 31. Should the Examiner maintain the grounds for rejection of these claims, Applicants respectfully request that the Examiner provide specific references to the components and portions of Kumar that the Examiner considers correspond to each and every element recited in Claims 31 and 32.

For at least the foregoing reasons, Kumar is missing multiple elements of Claims 11 to 15, 24 to 28, 31 and 32. Kumar cannot therefore form the basis for a § 102 rejection, and reconsideration and withdrawal of the § 102(b) rejection of Claims 11 to 15, 24 to 28, 31 and 32 are respectfully requested. Furthermore, Kumar cannot form the basis for a §103(a) rejection of these claims, as the record is devoid of a teaching of the missing elements or a reason to provide same.

Independent Claim 16 recites a method of facilitating providing an ad by loading an ad file, including identifying first, second and third files, identifying first and second placeholders in the third file, and electronically inserting the first file into the first placeholder and electronically inserting the second file into the second placeholder to create the ad file, the ad file including computer code for providing the ad.

The grounds for rejection of Claim 16 do not provide any specificity as to what in Kumar the Examiner believes corresponds with the claimed third file, identifying first and second placeholders in the third file, and/or electronically inserting the first file into the first placeholder

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and electronically inserting the second file into the second placeholder to create the ad file, the ad file including computer code for providing the ad. In view of the above discussion of Kumar with regard to Claim 11, it should be clear that Kumar fails to teach, suggest or disclose at least these features of Claim 16. Should the Examiner persist in reliance on Kumar as grounds for rejecting Claim 16, Applicants respectfully request the Examiner to clarify what specific components and portions of Kumar the Examiner considers to correspond to the claimed first, second and third files, the third file having first and second placeholders, identifying first and second placeholders in the third file, and electronically inserting the first file into the first placeholder and electronically inserting the second file into the second placeholder to create the ad file, the ad file including computer code for providing the ad.

Claims 17 to 23 depend from Claim 16 and are believed to be patentable over Kumar for at least the reasons noted with respect to Claim 16. In addition, Claims 17 to 23 recite additional elements which have been discussed with reference to dependent Claims 2 to 10, and 16, and are believed to be patentable over Kumar for reasons similar to those discussed with reference to Claims 2 to 10 and 16.

For at least the foregoing reasons, and in view of the fact that Kumar is missing multiple elements of the claims, Claims 16 to 23 are believed to be patentable over Kumar. Furthermore and since Kumar is missing multiple elements of the claims, Kumar cannot form the basis of a § 102 rejection, and reconsideration and withdrawal of the rejection of these claims are respectfully requested. Since the record is devoid of any teaching of the missing elements or a reason to provide same, Kumar cannot form the basis of a §103(a) rejection of these claims.

Furthermore and while the above discussion identifies more than ample reason to withdraw the §103(a) rejection of Claims 2 to 4, 13, 14, 22, 23, 26 and 28, the Office Action fails to provide a motivation or suggestion to modify to Kumar as proposed in the Office Action, and indeed no motivation or suggestion can be found in Kumar.

In view of the foregoing, the claims of the present application are believed to be patentable over the applied art. Furthermore and in view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

The Applicant respectfully requests that a timely Notice of Allowance therefore be issued in this case. Should matters remain which the Examiner believes could be resolved in a further telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred when charging any payments or credits for this case.

All correspondence should be directed to the below-listed address

Respectfully submitted,

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